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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/558,192	Applicant(s) NARASIMHASWAMY ET AL.	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>see att.</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 9/28/2007, Applicant amends claims 1, 16, 20, 27, and 40. The following claims 1-33, 37-41 are presented for examination.

1.1 In response to communications filed on 9/28/2007, the Double Patenting rejection has been withdrawn upon further consideration in view of the terminal disclaimer and the amendments.

1.2 Applicant's arguments filed on 9/28/2007 have been fully considered but they are not fully persuasive. With regard to claims 1, 16, 20, and 27, Applicant states that Lemble does not disclose permanently locking the disclosure as amended. Upon further consideration, a new ground of rejection is made in view of Lemble, Takano and Dziewit et al. With regard to claim 12, applicant argues on page 10, "Lemble's password is used so that a user can access their machine". Examiner respectfully disagrees with Applicant's interpretation because the machine referred to by Applicant is a user's virtual machine (VM) located in the server (not the user's terminal), therefore, the password is established so that a user can enter the system to access a particular disclosure, thus the password allows user access to the disclosure. Other users cannot access disclosure on one's user's machine because of the use of the password. See column 4, lines 3-25:

"As illustrated in FIG. 2, a user may initiate a session using any of the terminals attached to the network, and through a log-

Art Unit: 2136

on procedure reach his/her machine. Logging-on means sending an interrupt command from the keyboard to reach CP facilities and then identifying himself (herself) to the system by typing a personal identification code (userid) and in most cases a password. Password use enables forbidding access to a given "machine" by anyone but the machine "owner". Passwords are secret and known to the sole owner. Then CMS resources and/or any other software resources (e.g. IBM PROFS application programs) and/or any other specific software, such as the one designated here by "SEALING" designed for this invention, may either be accessed on request or be accessed directly. This is defined in the user's PROFILE EXEC routine tailored to identify the available resources assigned (i.e. made available) to the specific user upon originally defining the user's machine. For more detailed information on IBM PROFS one may refer to the following IBM document: Using the Professional Office System (Order No. SH20-5604)"

Note that Applicant's specification describes,

"Passwords or other security measures may be employed through the identification subsystem before access to the system may be gained. Preferably, a corporate directory service or other directory information may be used to assist the user in filling out the disclosure." (See page 9, lines 28-31).

"In step 302, hyperlinks may be established to the disclosure for use by the various committees, the patent staff evaluator, and the inventors. This hyperlink may also require the establishment of a password to enter the system and access the particular disclosure." (See page 17, line 30 - page 18, line 3).

Therefore, as shown above, it is correct to one of ordinary skill in the art to broadly and reasonably interpret the password disclosed by Lemble as being associated with the disclosure.

Applicant also states on page 11, "Lemble's "userid" and "serial number" are not passwords associated with a disclosure referring to column 26, lines 58-65. Examiner respectfully disagrees with Applicant's misinterpretation as Lemble clearly recites "Transfer

Art Unit: 2136

your Userid and Password". To further clarify, see column 26, lines 15-37 and column 26, line 64 through column 27, line 34:

"Under these circumstances stored data and any information belonging to one user need be transferred to another user (assignee). This is achieved, in VM environment, by transferring a VM machine from one individual to another. Under these circumstances however the signature delegation should be barred unless formally requested. The user can access this application by pressing PF8 in the SEALING Main Menu or directly typing SEALING EASPRET as a command. The following screen is then presented..." (column 26, lines 15-37)

```

... "Transfer your VM Userid and Password ----- Transferred VM
Userid : Userid . . . . VOIRON Owner . . . . Voiron, Jean
Serial number . 025456 Department . . . 0650 Receiving person :
Serial number . 079954 Owner . . . . . MILON Department . . .
0790 Reason for transfer . . . . . absent from 9/06/88 to
16/06/88 Indicate a protection code which will be asked when
retrieving your VM machine (It will not appear when typed) Type
it twice for control : .fwdarw. .fwdarw. PF9 Help PF12 Return

```

The user can see the complete identification of the chosen person. He can type an optional comment and he has to type twice a protection code which does not appear when typed. This code will be required for canceling the machine transfer.

The screen below is shown to the user when he pressed PF8 on SEALING Main Menu or typed SEALING EASPRET on the command line and when the VM has previously been declared as transferred.

```

----- Retrieve your VM Userid --
----- Transferred VM Userid : Userid . . . . VOIRON Owner . .
. . . Voiron, Jean Serial number . 025456 Department . . . 0650
Transfer date . 880609 Transfer time . 214759 Receiving person :
Serial number . 079954 Owner . . . . . MILON Department . . .
0790 Transfer reason . . . . . absent from 9/06/88 to
16/06/88 Indicate the protection code typed when you transferred
your VM (It will not appear when typed) .fwdarw. (0 attempts) PF9
Help PF12 Return" (column 26, line 64 through column 27, line 34)

```

Therefore, Examiner asserts that Lemble discloses not only a userid and serial number but also a password, and the password is associated with the disclosure. As disclosed above, a

Art Unit: 2136

screen is provided to a user to enter disclosure information which is stored in the SEALDBA (sealing database) and is prompted to provide a password associated with a disclosure and access to the disclosure is allowed after storing information in the database upon entering the password associated with the disclosure that meets the recitation of "said server providing user screens to said users so users provide disclosure information to said server; receiving disclosure information from said users, storing information in said database and prompting a user to provide a password associated with the disclosure and allowing the access to said disclosure after storing said information in said database upon entering the password associated with the disclosure.

With respect to claim 33, applicant argues on page 11, last paragraph that in Lemble the first user is the "Originator" and Lemble's system does not seek approval from its Originator". Examiner respectfully disagrees because the citations provided refer to user or approver and Lemble discloses in column 6, lines 9-15, column 19, line 50-column 20, line 11 that either the user or the approver can approve the document and the user can be an approver. In addition, the first user as claimed may be broadly and reasonably interpreted as being a first approver as disclosed in Lemble. Further clarification is provided in the rejection.

With regard to claim 40, applicant presents the same arguments as discussed above with respect to claims 1, 16, 20, and 27, therefore, a new ground of rejection is necessitated by the amendment of claim 40 as explained with respect to claims 1, 16, 20, and 27. No further arguments were presented by Applicant in view of the dependent claims, therefore, no further response is necessary by Examiner because of their dependency to the independent claims already discussed above. Upon further consideration, Applicant has not overcome the rejection of the claims and a new ground of rejection is set forth below as necessitated by the amendments.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 2/1/2007 was filed after the mailing date of the Non-Final Rejection on 9/26/2006. The submission is in compliance with the provisions of 37 CFR 1.97. The information disclosure statement filed on 2/1/2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. However, the other items that do comply with the requirements are being considered by the Examiner and initialed.

The information disclosure statement (IDS) submitted on 11/5/2007 and 12/5/2007 was filed after the mailing date of the Non-Final Rejection on 9/26/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

2. Claims 12, 16, and the intervening claims are objected to because of the following informalities: In claims 12 and 16, lines 5-6, the word "users" should be in singular. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 20-32, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of US Patent 5,031,214 to **Dziewit et al** (*Applicant's IDS*) and in view of US Patent 6,434,580 to **Takano**.

As per claim 1, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of selected information including a first inventor (user/approver) identification information from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 15-16); *as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); *prompting approval of said first inventor (user/approver)* (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); and **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure after approval, by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a

Art Unit: 2136

permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *after approval permanently locking the disclosure to prevent further editing of the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers

Art Unit: 2136

in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10).

As per claim 2, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 3, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see **Lemble**, column 10, lines 44-52).

As per claim 4, the combination of **Lemble, Dziewit et al, and Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 5, the combination of **Lemble, Dziewit et al, and Takano** discloses the limitation of wherein forming is performed by a non-inventor author (see **Lemble**, column 5, lines 15-20 and column 14, lines 40-60).

As per claim 6, the combination of **Lemble, Dziewit et al, and Takano** discloses the limitation of wherein the step of forming comprises identifying a second inventor; and further comprising the steps of notifying the second inventor; and, prompting the second inventor to approve the invention disclosure (see **Lemble**, column 18, lines 1-22; abstract, and figure 4).

As per claim 7, the combination of **Lemble, Dziewit et al, and Takano** discloses the limitation of further comprising revising the disclosure by the second inventor to form a revised disclosure, and prompting the first inventor to approve the revised disclosure (see **Lemble**, column 20, line 40 through column 21, line 54).

As per claim 8, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein prompting the second inventor comprises providing an E-mail to the second inventor (see **Lemble**, column 18, lines 1-22).

As per claim 9, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein prompting comprises the step of prompting the approval of an associated document (see **Lemble**, column 5, lines 21-25; column 9, lines 53-56; figures 4 and 6; and abstract).

As per claim 10, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses wherein the associated document is selected from a group consisting of an assignment document, and a power of attorney. **Takano** teaches preparing an online patent application which implicitly or inherently includes assignment document and power of attorney (see **Takano**, column 19, lines 14-53). Therefore, claim 10 is rejected on the same rationale as the rejection of claim 1 above.

As per claim 11, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising allowing access to various users for obtaining the information (see **Lemble**, column 5, lines 15-32 and abstract).

As per claim 20, **Lemble** substantially discloses an invention disclosure system comprising: *forming* electronic document approval online *by entering a plurality of selected*

information including a first inventor (user/approver) identification information and a second inventor (approver) identification information from a user computer (see column 6, lines 9-15; lines 35-36; column 10, lines 43-52; column 19, lines 50-55; column 20, lines 40-65; and abstract; and figures 15-16); as the plurality of selected information is entered into the user computer, storing the selected information in a central storage location (see column 5, lines 44-48; and figs. 2-3 with description); prompting approval of said first inventor (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); notifying the second inventor (approver) and, prompting the second inventor to approve the invention disclosure (see Lemble, column 18, lines 1-22; abstract, and figure 4). Lemble discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure to create a locked disclosure when the second inventor approves the disclosure (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. Lemble is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, Dziwit et al in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). Dziwit et al further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can

Art Unit: 2136

then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure when the second inventor approves the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10).

As per claim 21, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 22, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval (see **Lemble**, column 10, lines 44-52).

As per claim 23, the combination of **Lemble**, **Dziewit et al**, and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 24, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising locking the disclosure when the second inventor approves the disclosure (see **Lemble**, column 5, lines 33-40). (As shown in fig. 4 first or second approver (second inventor) can be the last approver).

As per claim 25, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising locking the disclosure when the first inventor approves the revised disclosure (see **Lemble**, column 20; column 6, lines 9-23; and column 5, lines 33-40). **Lemble** discloses a revised disclosure can be sent to a first user or first approver for approval if the user or first approver is the last approver locking the disclosure may take place.

As per claim 26, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein providing an E-mail to the second inventor comprises providing an E-mail to the second inventor having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 27, **Lemble** substantially discloses an invention disclosure system comprising: *forming electronic document approval online by entering a plurality of information including one or more inventor identifications from one or more inventors to form an invention disclosure from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 15-16); *storing the information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); *prompting approval of the one or more inventors*

Art Unit: 2136

(user/approver) (see column 5, lines 21-25; column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure to create a locked disclosure after each of the one or more inventors approve the disclosure, by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking to prevent further editing of the disclosure. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the disclosure to create a locked disclosure to prevent further editing of the disclosure after each of the one or more inventors approve the disclosure*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further

Art Unit: 2136

changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Lemble's invention is directed to fill in forms electronically as the form is made available to many selected users for approval and modification based on predefined approval rules and requestor identity. **Lemble** discloses the invention with respect to users and approvers in a company setting for preparing an electronic disclosure or form, but does not specifically refer to the form as an invention disclosure which inherently is prepared by users that include inventors and patent law persons. It would have required merely routine skill in the art to replace the users and approvers of **Lemble** by first/second inventor as it is well known that more than one inventor may be involved in a filing of an invention disclosure. **Takano** in an analogous art teaches preparing an online patent disclosure by inventor users with other patent application-filing persons including a patent attorney (see column 1, lines 1-19 and column 2, lines 1-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of **Lemble** into an invention disclosure environment, by combining the electronic filing document approval system of **Lemble** with the features of filing an invention disclosure by inventors and patent attorneys as taught by **Takano** for the purpose of conveniently preparing a patent application via a transmission and reception of application data between the inventor and other patent application-filing users as suggested by **Takano** (see column 1, line 63 through column 2, line 10).

As per claim 28, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising the step of generating an approval log (see **Lemble**, column 10, lines 44-52).

As per claim 29, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein the step of generating an approval log comprises recording the date of an approval from each of the one or more inventors (see **Lemble**, column 10, lines 44-52).

As per claim 30, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of further comprising associating the approval log with the disclosure (see **Lemble**, column 18, line 60 through column 19, line 14). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document.

As per claim 31, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein prompting comprises prompting the one or more inventor comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 32, the combination of **Lemble, Dziewit et al**, and **Takano** discloses the limitation of wherein providing an E-mail to the one or more inventors comprises providing an E-mail to the one or more inventors having a hyperlink to the disclosure therein (see **Lemble**, column 18, lines 1-22 and abstract).

As per claim 41, **Lemble** substantially discloses the claimed method of claim 33.

Takano teaches preparing an online patent application which implicitly or inherently includes assignment document and power of attorney (see **Takano**, column 19, lines 14-53). Therefore, claim 41 is rejected on the same rationale as the rejection of claim 1 above.

4. **Claims 16-19 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,315,504 to **Lemble** in view of US Patent 5,031,214 to **Dziewit et al** (*Applicant's IDS*).

As per claim 16, **Lemble** discloses an invention disclosure system comprising *a user computer, a server*, (see figure 1 and tables in column 7 and column 9); *a database coupled to the server* (see figure 1 and figure 3 and column 4, line 39). **Lemble** further discloses *said server providing user screens to said users to prompt users to provide disclosure information to said server*, (see figure 2 and claims 5-6); *receiving disclosure information from said users, including a first inventor identification and a second inventor identification* (see column 6, lines 9-15; column 19, lines 50-55; column 20, lines 40-65; and abstract); storing information in said database (see column 3, lines 40-62 and column 4, lines 25-47; column 29, lines 8-15; and figure 4); *prompting the first inventor and the second inventor to provide an approval* (see column 5, lines 20-40). **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure after the approval by the first inventor and the second inventor (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document

Art Unit: 2136

and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking of the document. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *locking the disclosure to prevent further editing after the approval by the first inventor and the second inventor*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

As per claim 17, **Lemble** discloses the claimed system of claim 16, wherein said server generated an approval log associated with said disclosure (see column 10, lines 44-52).

As per claim 18, **Lemble** discloses wherein said server associates said approval log with said disclosure (see column 10, lines 4-52 and column 18, line 60 through column 19, line 14).

As per claim 19, **Lemble** discloses the claimed system of claim 16, further comprising a directory system coupled to said server whereby upon providing identification information to server said server retrieves user information from the directory system in response to the identification information (see column 25, lines 10-33 and figures 3-4).

As per claim 40, **Lemble** discloses in column 5, lines 33-40 and column 6, lines 9-22, locking the disclosure when the second inventor approves the disclosure (as shown in fig. 4 first or second approver (second inventor) can be the last approver), by sending the document to a finalizing VM machine to perform a final update, format, and even encryption of the document and sending the document to another network node, performing a control operation to ascertain a higher security level. **Lemble** is silent as to this final process is a permanent locking of the document. However, **Dziewit et al** in an analogous art discloses (see column 2) producing a final authenticated document using computerized techniques which documents satisfies the legal document authentication and authenticity requirements (column 2, lines 5-15). **Dziewit et al** further discloses the document authentication process includes locking the document to prevent any further changes to thereby avoid tampering (see column 11, lines 13-27); appending a digital

signature to the final signed document (after approval by the parties) to prevent the document from being altered, the authenticated document with the digital signature appended thereto can then be electronically archived on electronic media as a permanent document (see column 2, lines 47-61 and column 8, lines 52-65), which meets the recitation of *permanently locking the document when the second user approves the document*. One of the advantages as disclosed by **Dziewit et al** is that the stored document can provide a permanent record to which a court can turn in the event of a dispute (see column 4, lines 18-20 and column 2, lines 41-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by **Lemble** to implement a permanent locking process to prevent any further changes as to thereby avoid tampering and also one of ordinary skill in the art would have been motivated to do so because it could provide a permanent record that may be used in a legal process as suggested by **Dziewit et al** (see column 2, lines 47-61 and column 8, lines 52-65, and column 11, lines 13-27).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-15, 33, and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,315,504 to **Lemble**.

As per claim 12, **Lemble** discloses an invention disclosure system comprising: *a user computer, a web server having an identification subsystem, (see figure 1 and tables in column 7 and column 9); a database coupled to the server (see figure 1 and figure 3 and column 4, line 39). Lemble further discloses said server providing user screens to said users so users provide disclosure information to said server, (see figure 2 and claims 5-6); receiving disclosure information from said users, storing information in said database (see column 3, lines 40-62 and column 4, lines 25-47; and claim 1) and (see also column 29, lines 8-15; and figure 4); Lemble discloses a screen is provided to a user to enter disclosure information which is stored in the SEALDBA (sealing database) and is prompted to provide a password associated with a disclosure and access to the disclosure is allowed after storing information in the database upon entering the password associated with the disclosure that meets the recitation of *prompting a user to provide a password associated with the disclosure and allowing access to said disclosure after storing said information in said database upon entering the password associated with the disclosure* (see column 4, lines 3-21; column 26, lines 15-37 and column 26, line 64 through column 27, line 34).*

As per claim 13, **Lemble** discloses the claimed system of claim 12, further comprising a directory system coupled to said server whereby upon providing identification information to

Art Unit: 2136

server said server retrieves user information from the directory system in response to the identification information (see column 25, lines 10-33 and figures 3-4).

As per claim 14, **Lemble** discloses the claimed system of claim 12, wherein said server creates a user log (see column (see column 10, lines 44-52).

As per claim 15, **Lemble** discloses the claimed system of claim 12, wherein said server associates said approval log with said disclosure (see column 10, lines 4-52).

As per claim 33, **Lemble** discloses an invention disclosure system comprising: *forming a document online by entering a plurality of selected information including a first user (user/approver column 14, lines 40-59) identification information from a user computer* (see column 6, lines 35-36; column 10, lines 43-52; and abstract; and figures 11, 15-16); (as interpreted by Examiner, Lemble discloses in column 6, lines 9-15, column 19, line 50-column 20, line 11 that either the user or the approver can approve the document and the user can be an approver); *storing the selected information in a central storage location* (see column 5, lines 44-48 and figs. 2-3 with description); prompting approval of said first user (user/approver) (see column 9, lines 53-56; column 6, lines 9-15; and figures 4 and 6); and generating an approval log comprising a date of approval by all inventors and associating the approval log with the document (see column 10, lines 44-52 and column 13, lines 1-8). **Lemble** discloses each document has an approval log associated with the document that can be view as a user selects the document (see column 18, line 60 through column 19, line 14).

As per claim 37, **Lemble** discloses further comprising the steps of notifying the second user; and, prompting the second user to approve the document (see column 18, lines 1-22; abstract, and figure 4).

As per claim 38, **Lemble** discloses revising the document by the second user to form a revised document, and prompting the first inventor to approve the revised document (see column 20, line 40 through column 21, line 54).

As per claim 39, **Lemble** discloses wherein prompting the second user comprises providing an E-mail to the second user (see column 18, lines 1-22).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2136

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the prior art discloses many of the claimed features.

6.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/

Carl Colin

Patent Examiner, AU 2136

November 28, 2007